

Applicant : Johnathan P. Tann
Appl. No. : 10/632,335
Examiner : Adam M. Queler
Docket No. : 13552.4003

Remarks/Arguments

Claims 1-8, 11-18, and 21-27 are pending of which claims 1 and 11 are independent. Claim 11 has been amended and claims 26-27 have been Cancelled. After amendment, claims 1-8, 11-18 and 21-25 remain. Applicant respectfully requests reconsideration of this application.

Section 112 Rejection

The examiner rejected claims 26-27 under the first paragraph of 35 U.S.C. § 112 and claim 26 under the second paragraph of 35 U.S.C. § 112. These claims have been Cancelled, thereby rendering these rejections moot.

Section 103 Rejection

The examiner rejected claims 1-8, 11-18, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over Kohl et al. (US Publication No. 20020091930A1) and applicant's admitted prior art. Applicant respectfully traverses this rejection and respectfully requests that the examiner reconsider his rejection in light of the amendments previously made to claim 1 and the presently submitted amendments to claim 11.

None of the references cited by the examiner, alone or in combination, teach searching for a suitable content player and installation of a suitable content player if one does not exist on the device, as is required by all pending claims. It is frequently the case, especially but not exclusively on handheld devices, that a content player appropriate for playing a certain type of media does not exist on the device and that a user must manually install a content player, a task that requires a certain level of technical competence. The inability to play media because the necessary content player is not available significantly limits the utility of devices like those in the cited and admitted prior art. The reason for this is that the lack of the correct content player prevents the automatic display/playback of the content rich data on the removable memory device when the media has been inserted into the device, unless the user manually intervenes and attempts to install the correct content player (assuming the user has access to the correct content player to install and has the requisite technical ability to perform such an installation).

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The subject matter of independent claims 1 and 11 solves this problem by “searching within the handheld device for a content player enabled to present the content rich data” and “installing a content player enabled to present the content rich data if a content player enabled to present the content rich data does not exist on the handheld device.” Thus, media content can be automatically displayed upon the installation of a removable media device, whether or not the appropriate content player has previously been installed by the user.

Kohl does not recite a content player, much less the searching and installing steps of claims 1 and 11. Moreover, even if a content player were inherent in Kohl, that does not make the searching and installing steps necessarily present. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Applicant respectfully submits that searching for an appropriate content player and installing such a content player after insertion of the memory device is not inherent in the cited art. In fact, these features are in no way “necessarily present” in the cited prior art. For example, in systems as in the cited prior art, when removable media with content to be played is inserted into a device and the appropriate player is not present on the device, the attempt to play the media will simply fail. Thus, searching for an appropriate content player and automatically installing the appropriate one if it is not present is not at all inherent in the prior art.

In fact, while Kohl teaches the playing of media content, Kohl fails to address the circumstance where an appropriate content player is not present. This does not render the conditional statement in the installing step of claims 1 and 11 false. Kohl makes the assumption that the media can be played; however, this assumption will be incorrect when media is placed in a device that does not have an appropriate content player. The subject matter claimed in the present application specifically addresses this situation by installing the correct content player if it is not present. As Kohl does not even consider what to do if the correct content player is not available, it cannot render the present claims obvious. Moreover, Applicant respectfully submits that Keyt and Colvin do not supply these limitations either. Colvin discloses a system for copy protection, and Keyt discusses copyright registration for web sites. Neither of these reference disclose content players much less the searching or installing steps of claims 1 and 11.

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Given this, the applicants respectfully submit that claim 1, claim 11 as amended, and their respective dependent claims are now in a condition for allowance, which is respectfully requested.

Conclusion

Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (650) 614-7660.

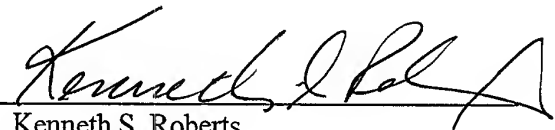
The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

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By: _____


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